



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/430,050	10/29/1999	MICHAEL S.H. CHU	1001.1258101	6707

7590 04/17/2002

DAVID M CROMPTON
CROMPTON SEAGER & TUFTE LLC
331 SECOND AVENUE SOUTH
SUITE 895
MINNEAPOLIS, MN 554012246

EXAMINER

LAM, ANN Y

ART UNIT	PAPER NUMBER
----------	--------------

3763

DATE MAILED: 04/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/430,050

Applicant(s)

CHU ET AL.

Examiner

Ann Y. Lam

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-15 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-15 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-9, 11-15 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Heck, 6,083,207, for the same reasons as set forth in Office action dated September 12, 2001.

As stated in the September 2001 Office action, Heck discloses means (212) for breaking said valve body along a predetermined location; means (70, 71) for coupling said valve body to a peel-away sheath for coupling said peel-away sheath lumen to said valve body lumen; means (50) for receiving a compressible valve sleeve having a lumen therethrough for coupling said valve sleeve lumen to said valve body lumen; and

Art Unit: 3763

means (52) for compressing said valve sleeve for restricting any fluid flow from said peel-away sheath lumen through valve and valve sleeve lumen.

As to claim 2, the valve sleeve inherently includes a free end extending past said means for compressing, and further comprising means (206) for receiving a catheter tip within said valve sleeve lumen free end while said means for compressing is compressing said valve sleeve, such that said valve sleeve lumen is substantially occluded by said inserted catheter tip while said catheter tip is inserted.

As to claim 3, Heck discloses a means (52, 20) for reversibly restricting fluid flow from said sheath lumen coupled to said sheath proximal end; means (70, 71) for breaking apart said fluid flow restricting means responsive to applied force; and means (50) for admitting a catheter distal end into said valve.

As to claim 4, the means (52, 20) for reversibly restricting flow has an open position for allowing flow therethrough and a closed position for substantially restricting flow, wherein said means (50) for admitting said catheter distal end includes means for admitting said catheter distal end while said means for restricting flow is in said closed position.

As to claim 5, said means (52, 20) for restricting flow includes a flexible, constrictable tube (20) having a lumen therethrough.

As to claim 6, said means (52, 20) for restricting flow includes means (52) for pinching said flexible tube for constricting said flexible tube lumen.

As to claim 7, said means for pinching has at least two portions (26, 28) movable with respect to each other, said two portions having means (52) for accepting and

Art Unit: 3763

pinching said flexible tube therebetween, said two portions together having an open position and a closed position.

As to claim 8, said movable pinching member portions are hingedly coupled together with at least one hinge, see column 7, lines 33-36, and see Figure 3.

As to claim 9, said sheath has a longitudinal axis and said at least one hinge has an axis substantially parallel with said sheath longitudinal axis and said hinge enables movement of said pinching member portions about said hinge longitudinal axis for pinching said flexible tube in said closed position, see column 7, lines 33-36, and see Figure 3.

As to claim 11, when in said closed position, said pinching members (52) include means for leaving sufficient space in said flexible tube lumen for passage of a guide wire.

As to claim 12, Heck discloses a tubular, distal introducer sheath (20) having a proximal region and a lumen therethrough, said sheath having at least one longitudinal strip (212) for preferentially tearing said sheath along said strip, see column 9, lines 7-9; a tubular, flexible, proximal valve sleeve (medical device, see column 9, lines 18-19) having a proximal region, a distal region, and a lumen therethrough; and a valve body (12) having a lumen therethrough and being sealingly coupled to said introducer sheath proximal region, said valve having at least one weakened region (near 94) for preferentially splitting said valve into at least two pieces responsive to an applied breaking force, said valve body having a seat (50) for mating to said proximal valve sleeve distal region, said valve body including a pinch member (52) for pinching said

Art Unit: 3763

flexible valve sleeve and having a closed position for constricting fluid flow through said valve sleeve and an open position for admitting a catheter inserted through said valve sleeve.

As to claim 13, said flexible valve sleeve includes a free portion proximal of said pinch member for admitting said catheter into said sleeve free portion while said pinch member is in said closed position.

As to claim 14, said valve body pinch member (52) includes a recess therein for allowing passage of a guide wire through said pinch member while said pinch member is in said closed position.

As to claim 15, Heck discloses a breakaway distal portion (20) having a lumen therethrough for receiving said introducer sheath proximal region; and a proximal portion (12) including two opposed valve body members (26, 28), at least one of which is movable relative to the other and having concave surfaces therebetween for receiving a flexible valve sleeve therebetween, said valve body opposed members having an open position and a closed position, wherein said valve body members move apart relative to each other to reach said open position and said valve body opposed members move together relative to each other to reach said closed position, see column 7, lines 33-37, and column 8, lines 26-30) wherein said flexible sleeve has a lumen therethrough and said sleeve and sleeve lumen are constricted between said body members in said closed position, such that fluid flow through said sleeve is substantially restricted in said closed position.

Art Unit: 3763

As to claim 21, said valve body members (26, 28) are considered pivotally mounted to each other along at least one hinge oriented substantially parallel to said valve body lumen longitudinal axis, see column 7, lines 33-37, and column 8, lines 26-30.

Response to Arguments

Applicant's arguments filed January 17, 2002 with respect to Lee '904 have been fully considered but are moot in view of Examiner's withdrawal of the rejection. Examiner has withdrawn the rejection based on Applicant's argument, which Examiner has interpreted to be asserting that the claimed means for compressing the valve excludes a self-sealing membrane as disclosed by Lee '904.

Applicant's arguments filed January 17, 2002 with respect to Heck '207 have been fully considered but they are not persuasive. Applicant argues that Heck does not disclose means for compressing the valve sleeve for restricting any fluid flow from the peel-away sheath lumen through valve and valve sleeve lumen. Examiner however reasserts that Heck discloses means (52) for compressing said valve sleeve for restricting any fluid flow from the peel-away sheath lumen through valve and valve sleeve lumen, as described above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3763

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Y. Lam whose telephone number is (703) 306-5560. The examiner can normally be reached on T-F 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on (703)308-3552. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-3590 for regular communications and (703)306-4520 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0858.

A.L.

April 11, 2002

ANHTUAN T. NGUYEN
PRIMARY EXAMINER

4/12/02